

REMARKS

Claims 1-5, 7-14 and 16-20, and newly added Claims 21-22, are pending herein. Claims 6 and 15 have been cancelled without prejudice or disclaimer.

1. Applicant thanks Examiners Hail and Scruggs for the courtesies extended to him and his undersigned attorney during a personal interview on September 27, 2005. The substance of the points discussed in the interview is provided below.

2. In the Office Action, Claims 1-5, 7-14 and 16-19 were rejected under 35 U.S.C. §102(e) over Carroll (U.S. Patent Application Publication 2004/0074344 A1, and Claims 11 and 20 were rejected under 35 U.S.C. §103(a) over Carroll in view of Lee (U.S. Patent 6,408,721 B1). For the reasons discussed below, and as pointed out in the interview, the claimed invention is neither anticipated by nor obvious over the cited references.

The present invention is directed to a variable length socket including cooperating first and second members having cooperating splines. The length of the socket can be adjusted by cooperatively moving the first and second members relative to each other. The socket of the present invention is unique in that it only requires two cooperating members to vary its length, thereby eliminating the need to have various length sockets (see paragraphs [0010] and [0013], on page 4-5, of the

application). The variable length socket of the present invention is further unique in that it is a simple two-piece device that does not require a separate or complicated locking mechanism (see paragraph [0012], on page 5, of the application).

In the interview, the patentability of Claim 1, as amended herein, was discussed. It was pointed out that Carroll discloses a multi-piece socket system, which includes at least two pieces: a drive adaptor 20 and a socket 40 (see Figure 1 of Carroll). The drive adaptor 20 and the socket 40 form an internal opening 100 to allow a long rod or other workpiece to extend thereinto. In the event, a greater depth for the inner opening 100 is required, an extension collar 70 is attached to the drive adaptor 20, and if even greater length or depth is required, more than one extension collars 70 are inserted between the socket 40 and the adaptor 20 (see paragraph [0024] of Carroll).

In other words, Carroll discloses a socket system that uses fixed length pieces thereby requiring the use of multiple pieces to expand its length. On the contrary, the claimed variable length socket uses only two pieces to adjust its length thereby eliminating the need to stock various fixed-length sockets.

Therefore, Carroll teaches extending the length of its socket by using a single or multiple extension collars of different lengths, which is precisely the opposite of the claimed invention wherein only two pieces are used to vary its length. Accordingly, it is respectfully submitted that Carroll's socket is completely different in design and construction, functions differently, and thus, teaches away from the claimed invention.

It is further respectfully submitted that Carroll uses a lock pin 56 in its socket 40 and a hole 36 in the drive adaptor 20 to interlock the two components (see paragraph [0019] of Carroll). As noted above, the claimed variable length socket does not require a separate or any complicated locking mechanism and frictionally locks the first and second members by the cooperating splines (see paragraph [0024], line 12-13, on page 8 of the present application).

In the interview, the Supervisory Primary Examiner (SPE) Hail stated that the language added to Claim 1, regarding adjustability of the length of the socket, amounts to functional language and therefore not entitled to patentable weight. In response, it is respectfully submitted that it is well-established law that there is nothing intrinsically wrong with the use of functional language in claims and that the PTO must afford patentable weight to functional limitations even if they are the only limitations that distinguish over the prior art. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990) and In re Land, 368 F.2d 866, 151 USPQ 621 (C.C.P.A.

1966).

It is respectfully submitted that the length of the socket of the present invention can be adjusted by cooperatively moving first and second members relative to each other. As noted above and pointed out in the interview, at least this feature of the claimed variable length socket distinguishes it over the prior art, where the length is adjusted by inserting one or more extension collars (see Figure 1 of Carroll). Therefore, it is submitted that the claimed variable length socket is patentable over the art of record.

In the interview, SPE Hail further suggested that the overall length of the Carroll socket can be adjusted to some degree by moving, for example, the drive adaptor 20 and socket 40, relative to each other. It is respectfully submitted, however, that there is no teaching or suggestion in Carroll for adjusting the length in this manner. As noted above, the length of the Carroll socket is modified by inserting one or more extension collars 70 between the drive adaptor 20 and the socket 40. In addition, the Carroll socket system utilizes a mechanism for interlocking, for example, drive adaptor 20 and a socket 40. Therefore, it is respectfully submitted that one of ordinary skill in the art would not either learn from Carroll or be motivated to adjust the length in the manner suggested by the Examiner. In this regard, it is respectfully submitted the Examiner's suggestion to use Carroll, as taught by the present invention, amounts to an "obvious to try"

suggestion that is legally insufficient to support an obviousness rejection. In re Roemer, 258 F.3d 1303, 59 USPQ2d 1527 (Fed. Cir. 2001).

Further, it is respectfully submitted that even if one were to adjust the length in the manner suggested by the Examiner, it might lead to an inoperable device since its locking mechanism would not operate. This is because, for example, the lock pin 56 and the corresponding hole 36 would only match when aligned properly (see paragraph [0025] of Carroll). If, as suggested by the Examiner, one were to move the pin 56 out of alignment from the hole 36, to adjust the combined length of the drive adaptor 20 and socket 40, the pin 56 would not extend in the corresponding hole 36, thereby producing a seemingly inoperative device. It has been held by the Federal Circuit that a *prima facie* case of obviousness cannot be sustained where a modification of the prior art device would render a device inoperable for its intended purpose. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose); McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969) (references teach away from combination if combination produces **seemingly inoperative device**); and In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

In this regard, and as noted above, there is no teaching or suggestion in Carroll for adjusting the length of its socket, in the manner suggested by the Examiner. The teaching for adjusting the length of the socket, by cooperatively moving two members relative to each other, is the present invention itself. To use the invention against the inventor amounts to improper use of hindsight, which is forbidden by law. As the Federal Circuit observed that

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field.... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (emphasis added)

In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000).

It appears that the Examiner believes that to adjust the length of the socket by cooperatively moving two pieces, i.e., first and second members relative to each other (as in the present invention), as opposed to using multiple pieces by providing one or more extension collars 70 (as in Carroll), is a simple and, therefore, obvious concept.

It is respectfully submitted that in the absence of any finding or suggestion in the prior art for the motivation to modify, in the manner suggested by the Examiner,

to arrive at the present invention, is improper. The Federal Circuit in In re Kotzab held that using a plurality of devices to arrive at the invention that only used one device was insufficient to sustain a case of obviousness, in the absence of any suggestion to modify the prior art. The court stated that

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.

Id., 55 USPQ2d at 1318.

Moreover, it is respectfully submitted that any unsupported statements that aspects of the invention are basic knowledge or common sense have been held by the Federal Circuit to be insufficient to sustain a rejection under 35 U.S.C. §103.

In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

In re Zurko, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Finally, it is respectfully submitted that Carroll fails to teach or suggest a two piece variable length socket wherein the internal diameter of the first member is generally constant throughout the length thereof (Claim 21) and wherein an internal

abutment separates first and second sections of the first member (Claim 22). As noted in paragraph [0026], on page 9, of the application, the abutment prevents over-extension of the spline section of the second member into the corresponding spline section of the first member, and over-extension of a component being manipulated by the socket into the recess.

In the Office Action, the Examiner, on page 3, subparagraph a.) states that Carroll discloses that the splines may be adapted to extend up to about a midpoint along the length of extension collar 70. It is respectfully submitted that paragraphs [0022] and [0027] cited by the Examiner, do not so state. In this regard, it is noted that Carroll, while mentions various lengths for the extension collar 70, it is silent on the length of splines extending upto a midpoint thereof.

For the foregoing reasons, it is respectfully submitted that Claims 1-5, 7-14 and 16-22, are neither anticipated by nor obvious over Carroll and Lee, alone or in any combination thereof.

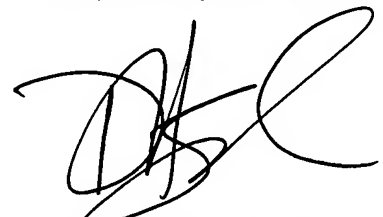
CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-5, 7-14 and 16-22 are in condition for allowance. Withdrawal of all of the objections and rejections and allowance of these claims are earnestly solicited.

It is believed that no additional fee is due for this submission. However, should that determination be incorrect, the Commissioner is hereby authorized to charge any deficiencies, or credit any overpayment, to our Deposit Account No. 01-0433, and notify the undersigned in due course.

Should the Examiner have any questions or wish to discuss further this matter, please contact the undersigned at the telephone number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'D. Agarwal', written over a horizontal line.

DINESH AGARWAL
Attorney for Applicant(s)
Reg. No. 31,809

Law Office - Dinesh Agarwal, P.C.
5350 Shawnee Road, Suite 330
Alexandria, Virginia 22312
Telephone: (703) 642-9400
Fax: (703) 642-9402

DA/va